



UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND
DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
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JAN 5 2001

In re

:
: DECISION ON
: PETITION FOR REGRADE
: UNDER 37 C.F.R. § 10.7(c)
:

MEMORANDUM AND ORDER

(petitioner) petitions for regrading questions 3, 7, 11, 16 and 19 of the morning section and questions 1, 10, 15, 25, 28, 36, 48, and 49 of the afternoon section of the Registration Examination held on April 12, 2000. The petition is denied to the extent petitioner seeks a passing grade on the Registration Examination.

BACKGROUND

An applicant for registration to practice before the United States Patent and Trademark Office (USPTO) in patent cases must achieve a passing grade of 70 in both the morning and afternoon sections of the Registration Examination. Petitioner scored 57. On July 19, 2000, petitioner requested regrading, arguing that the model answers were incorrect.

As indicated in the instructions for requesting regrading of the Examination, in order to expedite a petitioner's appeal rights, all regrade requests have been considered in the first instance by the Director of the USPTO.

OPINION

Under 37 C.F.R. § 10.7(c), petitioner must establish any errors that occurred in the grading of the Examination. The directions state: "No points will be awarded for incorrect answers or unanswered questions." The burden is on petitioners to show that their chosen answers are the most correct answers.

The directions to the morning and afternoon sections state in part:

Do not assume any additional facts not presented in the questions. When answering each question, unless otherwise stated, assume that you are a registered patent practitioner. Any reference to a practitioner is a reference to a registered patent practitioner. The most correct answer is the policy, practice, and procedure which must, shall, or should be followed in accordance with the U.S. patent statutes, the PTO rules of practice and procedure, the Manual of Patent Examining Procedure (MPEP), and the Patent Cooperation Treaty (PCT) articles and rules, unless modified by a subsequent court decision or a notice in the *Official Gazette*. There is only one most correct answer for each question. Where choices (A) through (D) are correct and choice (E) is "All of the above," the last choice (E) will be the most correct answer and the only answer which will be accepted. Where two or more choices are correct, the most correct answer is the answer which refers to each and every one of the correct choices. Where a question includes a statement with one or more blanks or ends with a colon, select the answer from the choices given to complete the statement which would make the statement true. Unless otherwise explicitly stated, all references to patents or applications are to be understood as being U.S. patents or regular (non-provisional) utility applications for utility inventions only, as opposed to plant or design applications for plant and design inventions. Where the terms "USPTO," "PTO," or "Office" are used in this examination, they mean the U.S. Patent and Trademark Office.

Petitioner has presented various arguments attacking the validity of the model answers.

All of petitioner's arguments have been fully considered. Each question in the Examination is worth one point.

Petitioner has been awarded one point for afternoon question 15. Accordingly, petitioner has been granted additional one point on the Examination. However, no credit has been awarded for morning questions 3, 7, 11, 16 and 19 and afternoon questions 1, 10, 25, 28, 36, 48, and 49.

Petitioner's arguments for these questions are addressed individually below.

Morning question 3 reads as follows:

3. A multiple dependent claim:

- (A) may indirectly serve as a basis for another multiple dependent claim.
- (B) added by amendment to a pending patent application should not be entered until the proper fee has been received by the PTO.
- (C) may directly serve as a basis for another multiple dependent claim.
- (D) is properly construed to incorporate by reference all the limitations of each of the particular claims to which it refers.
- (E) (B) and (D).

The model answer is choice (E).

(E) is correct because (B) and (D) are correct. 37 C.F.R. § 1.75(c); MPEP § 608.01(n) [pp. 600-66,67]. (A) and (C) are incorrect. MPEP § 608.01(n) (“[A] multiple dependent claim may not serve as a basis for any other multiple dependent claim, either directly or indirectly”).

Petitioner argues that answer (D) is correct because statement in answer (B) is incorrect.

Petitioner contends that (B) assumes that a fee is required, which would not be the case if multiple dependent claims were filed with the pending application.

Petitioner’s argument has been fully considered but is not persuasive. Answer (B) states that the multiple dependent claim was added by amendment to a pending patent application, therefore fee is required. Petitioner assumes additional facts not given in the question, specifically, the multiple dependent claim was filed with the pending application. Therefore, answer (E) is the best answer because both answers (B) and (D) are correct. No error in grading has been shown. Petitioner’s request for credit on this question is denied.

Morning question 7 reads as follows:

7. An application directed to hand shearing of sheep includes the following incomplete independent Claim 1 and dependent Claims 2-3.

Claim 1. An apparatus for shearing sheep, said apparatus comprising:

(i) a first cutting member having a first cutting edge at one end and a thumb loop at the other end;

(ii) a second cutting member having a second cutting edge at one end and a finger loop at the other end;

(iii) _____;

(iv) said second cutting member additionally including a pointer loop between said finger loop and said mid-point, said pointer loop having a pointer loop center, said finger loop having a finger loop center and said pointer loop having a pointer loop center such that a plane through said

finger loop center and said pointer loop center is generally parallel to said second cutting edge for improved balance.

Claim 2. The apparatus of claim 1, wherein said first cutting member includes a threaded aperture extending entirely through said first cutting member between said thumb loop and said mid-point, and an adjusting screw that extends through said threaded aperture to engage a bearing surface below the pointer loop on said second cutting member.

Claim 3. The apparatus of claim 2, wherein said connector is a rivet.

Which of the following most broadly completes missing paragraph (iii) of Claim 1?

(A) "wherein said first cutting member and said second cutting member are pivotally secured to each other at respective mid-points, and wherein said finger loop is padded; and"

(B) "said first cutting member having a mid-point between its ends and said second cutting member having a mid-point between its ends, wherein said first cutting member and said second cutting member are pivotally secured to each other at their respective mid-points by a connector; and"

(C) "said first cutting member including a reservoir for dispensing disinfectant solution and having a mid-point between its ends, said second cutting member having a mid-point between its ends, and wherein said first cutting member and said second cutting member are pivotally secured to each other at their respective mid-points by a connector; and"

(D) "said first cutting member and said second cutting member being pivotally secured to each other by a connector; and"

(E) "said first cutting member having a mid-point between its ends and said second cutting member having a mid-point between its ends, and said first cutting member and said second cutting member are pivotally secured to each other at

their respective mid-points; and”

The model answer is choice (B).

Answer (B) provides proper antecedent basis for “said mid-point” in part (iv) of Claim 1 and in Claim 2, and “said connector” in Claim 3. Answer (A) is incorrect at least because it does not provide antecedent basis for “said connector” in Claim 3. Answer (C) is narrower than Answer (B) because it includes the additional limitation of a reservoir and therefore does not “most broadly” complete claim 1. Answer (D) is incorrect because it does not provide proper antecedent basis for “said mid-point” in part (iv) of Claim 1 and in Claim 2. Answer (E) is incorrect because it does not provide antecedent basis for “said connector” in Claim 3.

Petitioner argues that the question should be thrown out because it requires that examinees assume information. Petitioner contends that the question did not ask that the claims must in compliance with 35 U.S.C. § 112. Petitioner did not present any argument on his selected answer (A).

Petitioner’s argument has been fully considered but is not persuasive. The examination instructions specifically provide that “[t]he most correct answer is the policy, practice, and procedure which must, shall, or should be followed in accordance with the U.S. patent statutes, the PTO rules of practice and procedure, the Manual of Patent Examining Procedure (MPEP), and the Patent Cooperation Treaty (PCT) articles and rules, unless modified by a subsequent court decision or a notice in the *Official Gazette*.” Answer (B) is the most correct answer followed in accordance with the U.S. patent statutes, in the case, 35 U.S.C. § 112, second paragraph. No error in grading has been shown. Petitioner’s request for credit on this question is denied.

Morning question 11 reads as follows:

Please answer questions 10 and 11 based on the following facts. Mario Lepieux was a member

of a Canadian national hockey team touring Europe. While traveling through Germany (a WTO member country) in December 1998, Mario conceived of an aerodynamic design for a hockey helmet that offered players improved protection while reducing air resistance during skating. Upon Mario's return to Canada (a NAFTA country), he enlisted his brothers Luigi and Pepe Lepieux to help him market the product under the tradename "Wing Cap." On February 1, 1999, without Mario's knowledge or permission, Luigi anonymously published a promotional article written by Mario and fully disclosing how the Wing Cap was made and used. The promotional article was published in Moose Jaw Monthly, a regional Canadian magazine that is not distributed in the United States. The Wing Cap was first reduced to practice on March 17, 1999. A United States patent application properly naming Mario as the sole inventor was filed September 17, 1999. That application has now been rejected as being anticipated by the Moose Jaw Monthly article.

11. Which of the following statements is most correct?

- (A) In a priority contest against another inventor, Mario can rely on his activities in Canada in establishing a date of invention.
- (B) In a priority contest against another inventor, Mario can rely on his activities in Germany in establishing a date of invention.
- (C) Mario can rely on his activities in Canada in establishing a date of invention prior to publication of the regional Canadian magazine article.
- (D) (A) and (C).
- (E) (A), (B), and (C).

The model answer is choice (E).

Answer (E) is correct because Mario may rely on activities in both Germany (a WTO member country) and Canada (a NAFTA country) in establishing a date of invention prior to publication of the Moose Jaw Monthly article or in establishing priority. 35 U.S.C. § 104; see also MPEP § 715.01(c).

Petitioner argues that credit should be given for his selected answer (D) because it includes a correct answer (A) or in the alternate this question should be thrown out since there is no best answer. Petitioner did not present any argument to support that his chosen answer (D) is the most correct answer.

Petitioner's arguments have been fully considered but they are not persuasive. Under 37 CFR 10.7(c), petitioner must establish any errors that occurred in the grading of the Examination.

The burden is on the petitioner to show that his chosen answer is the most correct answer. For this question, petitioner has not meet this burden because he did not present any argument for his chosen answer (C). Furthermore, the most correct answer is answer (E) for the reasons stated above. No error in grading has been shown. Petitioner's request for credit on this question is denied.

Morning question 16 reads as follows:

16. A patent specification discloses a personal computer comprising a microprocessor and a random access memory. There is no disclosure in the specification of the minimum amount of storage for the random access memory. In the disclosed preferred embodiment, the microprocessor has a clock speed of 100-200 megahertz. Claims 9 and 10, presented below, are original claims in the application. Claim 11, presented below, was added by amendment after an Office action.

9. A personal computer comprising a microprocessor and a random access memory including at least 1 gigabyte of storage.

10. The personal computer of Claim 9, wherein the microprocessor has a clock speed of 100-200 megahertz.

11. The personal computer of Claim 10, wherein the random access memory is greater than $\frac{1}{2}$ gigabyte of storage.

Which of the following statements is or are true about the respective claims under 35 U.S.C. § 112, fourth paragraph?

- (A) Claim 9 is a proper independent claim, and Claims 10 and 11 are proper dependent claims.
- (B) Claim 9 is a proper independent claim, and Claims 10 and 11 are improper dependent claims.
- (C) Claim 9 is an improper independent claim, and Claims 10 and 11 are improper dependent claims.
- (D) Claim 9 is an improper independent claim, and Claims 10 and 11 are proper dependent claims.

(E) Claim 9 is a proper independent claim, Claim 10 is a proper dependent claim, and Claim 11 is an improper dependent claim.

The model answer is choice (E).

(E) is the most correct answer. Claim 9, though broad, is supported by the specification. The minimum memory recited in the claim as original disclosure, is self-supporting. 35 U.S.C. § 112, first paragraph. Claim 10 is a proper dependent claim because it depends from and further restricts the scope of a preceding claim. 37 C.F.R. § 1.75(c). Claim 11 is an improper dependent claim because it expands upon, as opposed to further restricts, the scope of claim 10. Claim 10, depending on Claim 9, has a 1 gigabyte memory minimum, whereas Claim 11 expands upon the minimum memory by setting a lower minimum of ½ gigabyte.

Petitioner argues that answer (A) is the most correct. Petitioner contends that answer (A) is correct because the claims specifying the clock speed and the size of the memory which are limitations of the structure.

Petitioner's argument has been fully considered but is not persuasive. The question on asking about the respective claims under 35 U.S.C. § 112, fourth paragraph. Claim 11 is improper under 35 U.S.C. § 112, fourth paragraph, because it does not further restricts the scope of claim 10. The statement in answer (E) is correct. No error in grading has been shown. Petitioner's request for credit on this question is denied.

Morning question 19 reads as follows:

19. On February 1, 1999, you filed an application on behalf of Williams directed to a system for detecting expired parking meters. The specification fully supports original Claim 1, the sole claim. The application includes several drawings. One of the drawings shows a block diagram of the system, illustrating the electronics control unit as a box, labeled "electronics control unit." Claim 1 of the Williams application is as follows:

Claim 1. A system for detecting expired parking meters, comprising: a timer mechanism; an infrared sensor for detecting the presence of a parked vehicle; and an electronics control unit coupled to the infrared sensor and the timer mechanism.

You received a final Office action, dated February 1, 2000, containing an indication that claim 1 is allowable subject matter, but objecting to the specification, on the grounds that the subject matter of the electronics control unit, though adequately described in the original specification, was required to be shown in the drawings. Which of the following actions, if any, comports with proper PTO practice and procedure for overcoming the objection?

- (A) On April 1, 2000, file a Notice of Appeal, appropriate fees, and a brief pointing out that a patent should issue since the subject matter of the electronics control unit was adequately described in the original specification.
- (B) On April 1, 2000, file in the PTO a drawing illustrating only the portion of the electronics control unit that was described in the original specification.
- (C) On April 1, 2000, file a Notice of Appeal, appropriate fees, and a brief pointing out that the addition of a drawing showing the electronics control unit would not constitute addition of new matter since the electronics control unit was adequately described in the original specification.
- (D) On September 1, 2000, file a petition urging that no further drawing should be required because the subject matter of the electronics control unit, for purposes of the application, was adequately disclosed in the block diagram drawing.
- (E) None of the above.

The model answer is choice (B).

Answer (B) is correct. 37 C.F.R. § 1.83(a); MPEP §§ 608.02(d) and 706.03(o). Choices (A), (C), and (D) are incorrect. As stated in MPEP § 706.03(o), "If subject matter capable of illustration is originally claimed and it is not shown in the drawing, the claim is not rejected but applicant is required to add it to the drawing." See MPEP § 608.01(l). (D) is incorrect because the reply is not timely. (E) is incorrect because (B) is correct.

Petitioner argues that answer (E) is the most correct answer. Petitioner contends that it is after final and the objection is to the specification not the drawings. Petitioner also argues that it is doubtful that this issue could be raised now unless the examiner raised it for the first time after final.

Petitioner's argument has been fully considered but is not persuasive. The question states that the objection is on the grounds that the subject matter of the electronics control unit is not adequately shown in the drawings. Filing a drawing illustrating only the portion of the electronics control unit that was described in the original specification will overcome this

objection and would place the claim 1 in condition of allowance since the Office action indicated that claim 1 is allowable. Accordingly, answer (B) is correct. No error in grading has been shown. Petitioner's request for credit on this question is denied.

Afternoon question 1 reads as follows:

1. Which of the following does not constitute probative evidence of commercial success to support a contention of non-obviousness?

- (A) In a utility case, gross sales figures accompanied by evidence as to market share.
- (B) In a utility case, gross sales figures accompanied by evidence as to the time period during which the product was sold.
- (C) In a utility case, gross sales figures accompanied by evidence as to what sales would normally be expected in the market.
- (D) In a utility case, gross sales figures accompanied by evidence of brand name recognition.
- (E) In a design case, evidence of commercial success clearly attributable to the design, and not to improved performance of the device.

The model answer is choice (D).

(D) is correct because gross sales figures must be measured against a logical standard in order to determine whether or not there is commercial success. The recitations of accompanying evidence in (A), (B), and (C) are logical in that they provide a comparative basis for determining commercial success. (D), on the other hand, recites accompanying evidence which is illogical in that it does not provide a comparative basis for determining commercial success. (E) is wrong because it provides a logical basis for attributing commercial success to the design of the device, rather than the utilitarian function of the device. MPEP 716.03(b).

Petitioner argues that the question should be thrown out because answer (E) is probative and therefore not correct and the other answers are not truly probative.

Petitioner's argument has been fully considered but is not persuasive. As stated above, answer

(D) is correct because gross sales figures must be measured against a logical standard in order to determine whether or not there is commercial success. No error in grading has been shown. Petitioner's request for credit on this question is denied.

Afternoon question 10 reads as follows:

10. On December 1, 1998, Sam, attorney for the firm of Thrill and Chill, files a request for reexamination of a patent owned by his client, Hurley Corp., along with a recently discovered Russian patent which issued more than one year before the filing date of the patent. Hurley's patent contains one independent claim and nine dependent claims. The request for reexamination is granted on February 1, 1999. On June 1, 1999, an Office action issues in which the Examiner properly rejects independent claim 1 under 35 U.S.C. §§ 102 and 103 using the Russian reference and objects to the remaining claims as being dependent upon a rejected claim. Sam receives the Office action, agrees with the Examiner that claim 1 is unpatentable over the Russian patent and forwards it to his client, Hurley Corp. Hurley Corp. is undergoing financial problems and files for bankruptcy protection with the Federal District Court. They advise Sam that they have no funds available to further prosecute the reexamination proceeding. In accordance with proper PTO practice and procedure what should Sam do?

- (A) Advise the Examiner on the telephone that the patentee has filed for bankruptcy protection, and that nothing should be done in the reexamination proceeding until the bankruptcy is settled.
- (B) Do nothing and a reexamination certificate will issue indicating that claim 1 is canceled and that the patentability of claims 2 - 10 is confirmed.
- (C) File a fallacious reply arguing the patentability of claim 1 in order to allow the reexamination proceeding to continue.
- (D) File a divisional reexamination proceeding whereby claims 2 through 10 will be transferred into the divisional and allowed to issue. Claim 1, still in the original reexamination proceeding, can then be appealed to the Board of Patent Appeals and Interferences at a later point in time after the bankruptcy is resolved.
- (E) Send a letter to his client Hurley Corp. advising them that unless he is paid in advance, he will take no further action in the proceeding and file no papers with the PTO.

The model answer is choice (B).

Selection (B) is correct as per MPEP §§ 2287 and 2288. As to (E), Sam must request to withdraw

and obtain permission from the PTO in accordance with 37 C.F.R. § 10.40 and MPEP § 402.06. As to (A), bankruptcy will not stay a reexamination. As to (C), false representations are prohibited by the rules. As to (D), there are no divisional reexaminations.

Petitioner argues that the question should be thrown out. Petitioner contends that one of the most difficult questions in private practice is when a client won't or can't provide instructions and it's worst in reexamination practice because there are no continuations or abandonments.

Petitioner's argument has been fully considered but is not persuasive. The examiner and attorney are in agreement as to the status of the claims and no amendment or response of any kind from the patent owner or attorney is required. The statement in answer (B) is correct. A reexamination certificate will issue indicating that claim 1 is canceled and that the patentability of claims 2 - 10 is confirmed. No error in grading has been shown. Petitioner's request for credit on this question is denied.

Afternoon question 25 reads as follows:

25. You filed a patent application on behalf of Smith, an employee of Fix Corporation. The application contains a power of attorney authorizing you to transact all business before the Office on behalf of Smith. After the application is filed, Smith assigns all rights in the application to Fix Corp. In which of the following situations will the power of attorney granted to you be properly revoked?

I. Joe, in-house corporate counsel at Fix Corp., but not an officer of Fix, signs a submission, pursuant to 37 C.F.R. 3.73(b), establishing ownership of the entire interest in the application by Fix Corp., and forwards the submission along with a revocation of the power of attorney granted to you, to the PTO. Joe is not a registered practitioner, and he has not been authorized to bind Fix Corp.

II. Smith refuses to revoke the power of attorney given to you, but Snix, president of Fix Corp., signs a submission, pursuant to 37 C.F.R. 3.73(b), establishing ownership of the entire interest in the application by Fix Corp., and forwards the submission along with a Snix-signed revocation of the power of attorney granted to you, to the PTO.

III. Joe, in-house corporate counsel at Fix Corp., advises Snix, president of Fix Corp., that the assignment by Smith to Fix Corp. automatically operates as a revocation of the power of attorney granted to you, and Snix relies upon Joe's advice in good faith and takes no further action toward revoking the power of attorney. Joe is not a registered practitioner, and he has not been authorized to bind Fix Corp.

- (A) I.
- (B) II.
- (C) III.
- (D) I and II.
- (E) None of the above.

The model answer is choice (B).

Selection (B) is correct as per MPEP 324, and 402.07. The submission may be signed by a person in the organization having apparent authority to sign on behalf of the organization – an officer. In (B), the submission is signed by the President, an office having apparent authority. (I) and (III) are incorrect since Joe is neither a registered practitioner nor an officer of the company. (III) also is incorrect since the assignment by Smith to Fix does not automatically operate as a revocation of the power of attorney. 37 C.F.R. § 1.36. Thus, (A), (C), and (D) are incorrect. (E) is incorrect since (B) is correct.

Petitioner argues that (I) is also correct and therefore answer (D), the answer stating that both (I) and (II) are correct is the best answer. Petitioner contends that (I) would be correct where state law provided that an in-house corporate counsel may have the inherent ability to revoke powers of attorney. Petitioner concludes that answer (B) is incorrect because (I) is also correct and maintains that answer (D) is the best answer.

Petitioner's argument has been fully considered but is not persuasive. Contrary to petitioner's statement that state law may provide in-house counsel the inherent right to revoke powers of attorney, the question specifically states that Joe is not a registered practitioner, and he has not been authorized to bind Fix Corp. The instructions explicitly state to not assume any additional facts not presented in the questions. The factual basis for the question states that Joe lacks authority. Accordingly, the question is not premised on state law, but rather PTO rules and

regulations, rendering answer (D) incorrect. The statement in answer (B) is correct because (II) is correct, but not (I). No error in grading has been shown. Petitioner's request for credit on this question is denied.

Afternoon question 28 reads as follows:

28. Which of the following is **true**?

(A) On appeal of a rejection of ten claims to the Board of Patent Appeals and Interferences, each appealed claim stands or falls separately as a result of appellant pointing out differences in what the claims cover.

(B) The 2-month period for filing a petition mentioned in 37 C.F.R. § 1.181(f) is extendable under 37 C.F.R. § 1.136(a).

(C) An examiner may enter a new ground of rejection in the examiner's answer to an applicant's appeal brief.

(D) After filing a notice of appeal, an applicant is estopped from further prosecuting the same claims in a continuation application.

(E) When desiring to claim foreign priority, the oath or declaration in a reissue application must claim foreign priority even though the priority claim was made in the original patent.

The model answer is choice (E).

Selection (E) is correct. See MPEP § 1414 Content of Reissue Oath/Declaration and 37 C.F.R. § 1.175(a) which states that reissue oaths/declarations must meet the requirements of 37 C.F.R. § 1.63, including 1.63(c) relating to a claim for foreign priority. As to (A), 37 C.F.R. § 1.192(c)(7) requires appellant to state that the claims do not stand or fall together. Appellant must present appropriate argument under 37 C.F.R. § 1.192(c)(8) why each claim is separately patentable. Merely pointing out differences in what the claims cover is not argument why the claims are separately patentable. MPEP § 1206, pages 1200-8 and 9. As to (B), see MPEP § 1002. As to (C), 37 C.F.R. § 1.193(a)(2) prohibits the entry of a new ground of rejection in an examiner's answer. As to (D), continuation may be filed during pendency of parent.

Petitioner argues that answer (C) is the best answer because petitioner knows that an

examiner may make a new ground of rejection added after final. Petitioner contends that answer (E) is incorrect because the claim for foreign priority is not required to be made in the declaration or oath.

Petitioner's argument has been fully considered but is not persuasive. Answer (C) is incorrect because 37 C.F.R. § 1.193(a)(2) prohibits the entry of a new ground of rejection in an examiner's answer. Answer (E) is correct because 37 C.F.R. § 1.63(c) states that the oath or declaration in any application in which a claim for foreign priority is made pursuant to 37 CFR 1.55 must identify the foreign application for patent or inventors certificate on which priority is claimed and any foreign application having a filing date before that of the application on which priority is claimed, by specifying the application number, country, day, month, and year of its filing. The statement in answer (E) is correct. No error in grading has been shown. Petitioner's request for credit on this question is denied.

Afternoon question 36 reads as follows:

36. Which of the following is true?

- (A) As a registered practitioner, it is not necessary to notify the Director of Enrollment and Discipline of your address changes as long as you file a change of address in each individual application for which you are responsible.
- (B) At any time the Director of Enrollment and Discipline may send out letters to registered practitioners for the purpose of ascertaining whether they wish to remain on the register and if no reply is received, without further warning, the name may be removed from the register.
- (C) A practitioner may not refuse to aid or participate in conduct that the practitioner believes to be unlawful, even though the client presents some support for an argument that the conduct is legal.
- (D) Any person who passes this examination and is registered as a patent agent or patent attorney is entitled to file and prosecute patent applications and trademark registration applications before the PTO for the same client.

(E) It is permissible to give examiners gifts valued at between \$25 and \$250 so long as the gift is made after issuance of all patent applications that the practitioner or the practitioner's firm has before the Examiner.

The model answer is choice (B).

Answer (B) is correct, see 37 C.F.R. § 10.11(b), where "the names of individuals so removed will be published in the Official Gazette." The rule does not require notice to be published before the names of individuals are removed. As to (A), a practitioner must notify the Director as set forth in 37 C.F.R. § 10.11 (a). As to (C), see 37 C.F.R. § 10.84(b)(2). As to (D) registration only entitles one to practice before the USPTO in patent cases. 37 C.F.R. §§ 10.5 and 10.14(a). As to (E), see 37 C.F.R. § 10.23(c)(4)(iii) regarding improperly bestowing of any gift, favor or thing of value.

Petitioner argues that the question should be thrown out because 37 CFR 10.239(iii) merely states that improper gift should not be given to an examiner and "improper" has not been defined. Petitioner did not present any argument for his selected answer (A).

Petitioner's argument has been fully considered but is not persuasive. Under 37 CFR 10.7(c), petitioner must establish any errors that occurred in the grading of the Examination. The burden is on the petitioner to show that his chosen answer is the most correct answer. For this question, petitioner has not meet this burden because he did not present any argument for his chosen answer (A). Answer (B) is correct for the reasons stated above. No error in grading has been shown. Petitioner's request for credit on this question is denied.

Afternoon question 48 reads as follows:

48. Which of the following statements regarding 35 U.S.C. § 103 is most correct?

(A) PTO classification of prior art references used to reject a claim under 35 U.S.C. § 103, and the similarities and differences in structure and function carry equal weight as evidence of whether the references are analogous or non-analogous.

(B) The question of obviousness under 35 U.S.C. § 103 is resolved by determining whether the

differences between the prior art and the claims would have been obvious.

(C) Obviousness of an invention can be properly determined by identifying the "gist" of the invention, even where the "gist" does not take into regard an express limitation in the claims.

(D) In delineating the invention, consideration is given not only to the subject matter recited in the claim, but also the properties of the subject matter which are inherent in the subject matter and disclosed in the specification.

(E) Obviousness can be predicated on what is not known at the time an invention is made, where the inherency of the feature is later established.

The model answer is choice (D).

(D) is the most correct answer as per 35 U.S.C. § 103(a); *In re Antonie*, 559 F.2d 618, 620, 195 USPQ 6, 8 (CCPA 1977) ("In delineating the invention as a whole, we look not only to the subject matter which is literally recited in the claim in question...but also to those properties of the subject matter which are inherent in the subject matter *and* are disclosed in the specification..."); MPEP 2141.02 (section styled, "Disclosed Inherent Properties Are Part of 'As A Whole' Inquiry"). (A) is incorrect. MPEP 2141.01(a). PTO classification is some evidence of analogy/non-analogy, but **structure and function carry more weight**. *In re Ellis*, 476 F.2d 1370, 1372, 177 USPQ 526, 527 (CCPA 1973). (B) is incorrect. MPEP 2141.02. The question under 35 U.S.C. § 103 is whether the claimed invention as a whole would have been obvious. *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 218 USPQ 871 (Fed. Cir. 1983). (C) is incorrect. MPEP 2141.02 (section styled, "Distilling The Invention Down To a 'Gist' or 'Thrust' Of An Invention Disregards 'As A Whole' Requirement"). *W. L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984); *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561, 1 USPQ2d 1593 (Fed. Cir. 1987), *cert. denied*, 481 U.S. 1052 (1987) (district court improperly distilled claims down to a one word solution to a problem). (E) is incorrect. As stated in MPEP 2141.02 (section styled, "Disclosed Inherent Properties Are Part Of 'As A Whole' Inquiry"), "Obviousness cannot be predicated on what is not known at the time an invention is made, even if the inherency of a certain feature is later established. *In re Rijckuert*, 9 F.2d 1531, 28 USPQ2d 1955 (Fed. Cir. 1993)."

Petitioner argues that answer (B) is correct. Petitioner contends that answer (D) is incorrect.

Petitioner's argument has been fully considered but is not persuasive. Answer (D) is correct for the reasons stated above. Answer (B) is incorrect because the question under 35 U.S.C. § 103

is whether the claimed invention as a whole would have been obvious. *Stratoflex, Inc. v.*

Aeroquip Corp., 713 F.2d 1530, 218 USPQ 871 (Fed. Cir. 1983). Also see MPEP 2141.02. No

error in grading has been shown. Petitioner's request for credit on this question is denied.

Afternoon question 49 reads as follows:

49. A parent application A was filed on September 9, 1988, and became abandoned on October 19, 1993. Application B was filed on October 21, 1993, and referred to application A as well as claimed the benefit of the filing date of application A. Application B issued as a patent on June 17, 1997. Application C was filed on October 29, 1993, and referred to application B as well as claimed the benefit of the filing date of application B. Application D was filed on December 20, 1996. Application D referred to application B and claimed the benefit of the filing date of application B. Both applications C and D were abandoned for failure to file a timely reply to Office actions that were mailed on April 20, 1999. Application E was filed on July 22, 1999 and is drawn to the same invention as claimed in applications C and D. Application E claims the benefit of the filing dates of applications A, B, C, and D, and makes reference to all preceding applications. The earliest effective filing date of application E with respect to any common subject matter in the prior applications is:

- (A) October 21, 1993.
- (B) December 20, 1996.
- (C) October 29, 1993.
- (D) September 9, 1988.
- (E) July 22, 1999.

The model answer is choice (E).

The applications C and D were abandoned after midnight of July 21, 1999, therefore they are technically abandoned on July 21, 1999. There is no copendency between applications E and any prior application. MPEP § 201.11 ("If the first application is abandoned, the second application must be filed before the abandonment in order for it to be co-pending with the first."). See MPEP § 710.01(a), fourth paragraph.

Petitioner argues that the question should be thrown out because it requires facts not given such as when the applications C and D abandoned. Petitioner did not present any arguments for his selected answer (A).

Petitioner's argument has been fully considered but is not persuasive. Under 37 CFR

10.7(c), petitioner must establish any errors that occurred in the grading of the Examination. The burden is on the petitioner to show that his chosen answer is the most correct answer. For this question, petitioner has not meet this burden because he did not present any argument for his chosen answer (A).

As explained in MPEP § 710.02(b), under the authority given him by 35 USC § 133, the Commissioner has directed the examiner to set a shortened period for reply to every action. That same MPEP section also states that such shortened period is 3 months to reply to any Office action on the merits. Accordingly, the Office actions that were mailed on April 20, 1999 for applications C and D were assigned shortened periods according to the PTO rules of practice and procedure, rendering C and D abandoned at the time of E's filing and making the correct answer (E). No error in grading has been shown. Petitioner's request for credit on this question is denied.

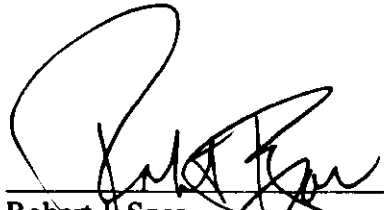
The regrade of the petitioner's examination has been conducted fairly and without discrimination pursuant to a uniform standard using the PTO's model answers. See *Worley v. United States Patent and Trademark Office*, No. 99-1469, slip op. at 4 (D.D.C. Nov. 8, 2000) (The court held that the PTO's Model Answers are a uniform standard. "[S]ince all exams are graded in reference to [the Model Answers], use of the Model Answers fosters uniformity in grading and preclude[s] unfair and individually discriminatory grading." *Id.*, slip opinion at 5. The court concluded that "the decision of the Commissioner of the USPTO not to regrade Mr. Worley's examination answers as correct when the answers did not conform with the USPTO's Model Answers was not arbitrary and capricious." *Id.*, slip opinion at 5-6.)

ORDER

For the reasons given above, one point has been added to petitioner's score on the Examination. Therefore, petitioner's score is adjusted to 58. This score is insufficient to pass the Examination.

Upon consideration of the request for regrade to the Director of the USPTO, it is ORDERED that the request for a passing grade on the Examination is denied.

This is a final agency action.



Robert J. Spar
Director, Office of Patent Legal Administration
Office of the Deputy Commissioner
for Patent Examination Policy